

REMARKS

The Examiner is thanked for the performance of a thorough search. By this amendment, Claims 1, 6, 8, 9, 10, 13, and 14-28 have been amended. No claims have been added. No claims have been canceled. Hence, Claims 1-28 are pending in this application. The amendments to the claims do not add any new matter to this application. Furthermore, the amendments to the claims were made to improve the readability and clarity of the claims and not for any reason related to patentability. All issues raised in the Office Action are addressed hereinafter.

I. CLAIM REJECTIONS BASED ON 35 U.S.C. § 101

Claims 15-28 were rejected under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. Specifically, the Office Action alleged that Claims 15-28 were “software *per se*” and therefore “functional descriptive material [that] . . . is non-statutory subject matter.” The rejection is respectfully traversed.

35 U.S.C. § 101 “defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter.” MPEP 2106.IV.A. Claims 15-28, reciting “machine-readable storage medium[s],” are manufactures.

The Office Action alleges that Claims 15-28 are “functional descriptive material *per se*,” as well as “software *per se*.” Applicants dispute these characterizations. As stated in MPEP 2106.01, “‘functional descriptive material’ consists of data structures and computer programs which impart functionality when employed as a computer component.” The machine-readable storage media of Claims 15-28 are not “functional descriptive material,” because any functional descriptive material included in the claims is stored on tangible, machine-readable storage media. *See* MPEP 2106.01 (“When functional descriptive material is **recorded on some computer-readable medium**, it becomes structurally and functionally interrelated to the medium and **will be statutory** in most cases since use of technology permits the function of the descriptive material to be realized.”).

Thus, Claims 15-28 presently recite articles of manufacture and are directed towards statutory subject matter under 35 U.S.C. § 101. Removal of the rejection is requested.

II. CLAIM REJECTIONS BASED ON 35 U.S.C. § 102

Claims 1-28 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 7,202,972 to Schwier, et al. (hereinafter Schwier). Applicants traverse the rejection. Reconsideration is respectfully requested.

To anticipate under 35 U.S.C. § 102, a reference must show all elements, steps, or limitations of a claim, arranged as in the claim. An anticipation rejection is unsupported or overcome if a reference is missing even one element, step, or limitation. *See Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

INDEPENDENT CLAIM 1

Claim 1 as set forth in the listing of claims clarifies that the method features, among other elements:

receiving, at a merge utility executing on a computer system, a first merge document that is in a merge format;
converting a second document from an original format to the merge format to create a second merge document;
wherein the second document was created by a first document authoring application;
wherein the step of converting is performed by either the merge utility or the first document authoring application;
using the merge utility, merging the first merge document and the second merge document to generate a composite merge document; and
delivering said composite merge document to an output device;

For example, a computer system implementing the method of Claim 1 might feature a merge utility. The computer system may also feature a document authoring application. A user might create a document in the document authoring application (i.e. the second document). A user may wish to print this document with a pre-defined watermark. To do so, a user might click on a button that sends the document to the merge utility, along with another document (i.e. the first

document, which may be, for example, a watermark). The merge utility would convert the document to a “merge format” capable of being understood by a printer (i.e. PCL). The other document (i.e. the watermark) may already be in this merge format. The two documents are merged together into one (i.e. the composite document). The merge utility may then deliver the composite document directly to the printer for printing.

In Schwier, on the other hand, a user creates a **single document** comprising static data and variable data. **Prior to being converted** to a format suitable for printing, a filter event separates the static data from the filter data. Schwier, col. 7, lines 7-17. Separately, the variable data and the static data are converted to a format suitable for printing. Schwier, col. 6, lines 49-56. The converted variable data and converted static data **must be sent to a printer separately**. *E.g.*, Schwier, col. 6, lines 49-56. The printer stores the static data on the printer for re-use. Schwier, col. 6, lines 33-35. The **printer** then **performs the step of merging** the static data and the variable data back into a single document. Schwier, col 6, lines 63-65. The printer must be specially programmed to perform this step.

Schwier does not disclose many of the elements of Claim 1. For instance, Schwier does not use a merge utility **executing on the computer system** to “merg[e] the first merge document and the second merge document to generate a composite merge document.” Rather, Schwier relies on the output device to perform the step of merging. While the Office Action suggests that this element can be found in Schwier, cols. 7, lines 4-6, it is clear that this merger in Schwier happens on Schwier’s printer, and does not happen until after all of the data has been sent to Schwier’s printer.

For at least the foregoing reason, Schwier does not disclose every element of independent Claim 1, and thus cannot anticipate Claim 1 under 35 U.S.C. § 102. Reconsideration is respectfully requested.

DEPENDENT CLAIMS 2-28

Claims 2-28 depend from Claim 1, and include each of the above-quoted features by dependency. Thus, Schwier also lacks at least one feature found in Claims 2-28. Therefore, Schwier does not anticipate Claims 2-28. Removal of the rejection is respectfully requested.

In addition, each of Claims 2-28 recites at least one feature that independently renders it patentable. For example, Claim 9 features, among other elements:

passing [a] set of conversion instructions from the merge utility to the first document authoring application; and
the first document authoring application generating the second merge document based on said set of conversion instructions.

The Office Action alleges that “passing [a] set of conversion instructions to a document authoring application” may be found in Schwier, col. 4, lines 15-20. However, this portion of Schwier does not show **a merge utility passing a set of instructions**, as Claim 9 presently recites. Even more specifically, Claim 9 requires that merge utility pass the instructions to the document authoring application **that created the second document**. Schwier does not disclose or suggest anything like this.

As another example, Claim 11 recites that “the composite merge document is in the merge format.” Thus, as defined by Claim 11, a composite merge document must be in the merge format, and must be delivered to the output device. The Office Action alleges that such a composite merge document is disclosed in Schwier, lines 56-67. However, these lines merely describe how a single document containing variable and static data is converted to EMF format (a non-merge format) that is subsequently separated into two documents prior to being converted to PCL (a merge format).

In fact, Schwier does not disclose a composite merge document within the meaning of Claim 11. The static data and the variable data are separated before they are converted into a PCL (or other printer-compatible) data stream. Prior to this time, the combination of static and variable data cannot be considered a composite merge document, because it is not in the merge format. Since merger of the separated static and variable data does not occur until after the data has been sent to the printer, no “composite merge document” is ever “delivered” to Schwier’s output device. Thus the merged document on the printer is also not a “composite merge document.”

As another example, Claim 12 recites that the “composite merge document is a template for creating other documents.” The Office Action alleges that Schwier discloses this feature by virtue of the fact that Figure 5 of Schwier shows a master document. However, the master document of Figure 5 in Schwier is not a composite merge document. While Figure 5 does show a master document, this master document is not merged from two documents in the merge format, as is a composite merge document. Rather, the master document of Figure 5 is created at a document authoring program, and will subsequently be separated into static data and

variable data. At no time does Schweir disclose a composite merge document behaving as a template.

However, to expedite prosecution in light of the fundamental differences already identified, separate arguments for each patentable feature of Claims 2-28 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

CONCLUSION

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone relating to any issue that would advance examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a check for the petition for extension of time fee and other applicable fees is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,
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